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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,535	12/04/2000	Kiyomi Nakamura	503.39364X00	4344

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EXAMINER

IP, SIKYIN

ART UNIT PAPER NUMBER

1742

DATE MAILED: 04/10/2002

/6

Please find below and/or attached an Office communication concerning this application or proceeding.

MF=10

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	Examiner	Group Art Unit	

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

**Status**

- ☒ Responsive to communication(s) filed on 1/28/02
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

**Disposition of Claims**

- ☒ Claim(s) 1-26 is/are pending in the application.
- Of the above claim(s) 12-21 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-11, 22-26 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

**Application Papers**

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119 (a)-(d)**

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
  - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

**Attachment(s)**

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 8
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

**Office Action Summary**

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-2, 4-11, and 22-25 are rejected under 35 U.S.C. § 103 as being unpatentable over USP 2000115 to Wood (claims 1-2), DE 1301914, NO 20675, DE 1259578, or USP 4332864 to King et al. (abstract).

4. Claims 1-2, 6-7, 9-11, and 22-24 are rejected under 35 U.S.C. § 103 as being unpatentable over GB 1291553 (page 1, lines 60-68), or USP 3653880 to Gitlesen.

5. Claims 1-3, 6-7, 9-11, and 22-24 are rejected under 35 U.S.C. § 103 as being unpatentable over DE 1934617.

6. Claims 1, 3-11, and 22-25 are rejected under 35 U.S.C. § 103 as being unpatentable over USP 5964965 to Schulz et al (abstract).

7. Claims 6, 7, 10, and 23 are rejected under 35 U.S.C. § 103 as being unpatentable over USP 4675157 to Das et al (Table 1, sample 5).

8. The cited reference(s) disclose(s) the features including the claimed Mg based alloy compositions. The features relied upon described above can be found in the reference(s) at: their abstracts. The difference between the reference(s) and the claims are as follows: Some cited references may have elements just outside the claimed range, do not disclose the claimed grain size, and/or do not disclose the claimed properties. However, it is well settled that a prima facie case of obviousness would exist where the claimed ranges and prior art do not overlap but are close enough that one skilled in the art would have expected them to have the same properties, *In re Titanium Metals Corporation of America v. Banner*, 227 USPQ 773 (Fed. Cir. 1985), *In re Woodruff*, 16 USPQ 2d 1934, and *In re Aller*, 105 USPQ 233. The Mg based alloys of cited references also known for die casting such as alloy wheels.

9. Moreover, the instant Mg based alloy compositions are overlapped by the cited references; consequently, the properties as recited in the instant claims would have inherently possessed by the teachings of the cited references. Therefore, the burden is on the applicant to prove that the product of the prior art does not necessarily or inherently possess characteristics attributed to the claimed product. *In re Spade*, 911

F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

In re Best, 195 USPQ, 430 and MPEP 2112.01.

“Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, *In re Best*, 195 USPQ 430, 433 (CCPA 1977). ‘When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.’ *In re Spada*, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 195 USPQ 430, 433 (CCPA 1977).” see MPEP §2112.01

#### *Response to Arguments*

10. Applicant's arguments filed January 28, 2002 have been fully considered but they are not persuasive.

11. Applicants' argument in paragraph bridging pages 12 and 13 of the instant remarks is noted. But, there is no evidence the claimed Al proportion is critical. It is well settled that a prima facie case of obviousness would exist where the claimed ranges and prior art do not overlap but are close enough that one ordinary skilled in the art would have expected them to have the same properties, *In re Titanium Metals Corporation of America v. Banner*, 227 USPQ 773 (Fed. Cir. 1985), *In re Woodruff*, 16 USPQ 2d 1934, and *In re Aller*, 105 USPQ 233.

12. Applicants' argument as set forth in second full paragraph of page 13 of the

instant remarks is noted. But, examiner reiterates the same rational of item 11 above.

13. Applicants argue that the alloy in reference list (10) is in powder form. But powder is also formed by cast/atomize/spray cast from molten alloy. Therefore, Mg based alloy powder of cited reference is also a cast alloy.

14. Applicants argue that reference (10) in the list does not disclose the claimed alloy composition. The examiner disagrees. Applicants' attention is directed the abstract of said reference which discloses the claimed elements and their proportions overlapping the claimed alloys.

15. Applicants argue that the alloy of USP '965 does not contain Al. Applicants' attention is directed to abstract of said reference, for example, Al is listed under "A".

### *Conclusion*

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

The above rejection relies on the reference(s) for all the teachings expressed in the text(s) of the references and/or one of ordinary skill in the metallurgical art would have reasonably understood or implied from the text(s) of the reference(s). To

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emphasize certain aspect(s) of the prior art, only specific portion(s) of the text(s) have been pointed out. Each reference as a whole should be reviewed in responding to the rejection, since other sections of the same reference and/or various combination of the cited references may be relied on in future rejection(s) in view of amendment(s).

All recited limitations in the instant claims have been met by the rejections as set forth above.


Applicant is reminded that when amendment and/or revision is required, applicant should therefore specifically point out the support for any amendments made to the disclosure. See MPEP § 2163.06 (a) and 37 C.F.R. § 1.119.

*Examiner Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Ip whose telephone number is (703) 308-2542. The examiner can normally be reached on Monday to Friday from 5:30 A.M. to 2:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy V. King, can be reached on (703)-308-1146.

The facsimile phone number for this Art Unit 1742 are (703) 305-3601 (Official Paper only) and (703) 305-7719 (Unofficial Paper only). When filing a FAX in Technology Center 1700, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communication with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

  
\_\_\_\_\_  
SIKYIN IP  
PRIMARY EXAMINER  
ART UNIT 1742

S. Ip  
April 7, 2002